

## REMARKS

Prior to this response, Claims 1-15 were pending in this application, with Claims 14 and 15 withdrawn from consideration. Claim 16 is added and no claims are canceled. Hence, Claims 1-16 are presently pending in this application, with Claims 1-13 and 16 under examination and Claims 14 and 15 withdrawn from consideration.

## OBJECTIONS

### In the Specification

The Office Action objected to the specification on the premise that, in the Abstract, “legal phraseology often used in patent claims ... should be avoided.” Specifically, the Office Action objects to the Abstract because it contains the term “comprises”. Applicant declines to make any further changes to the Abstract, for the following reasons.

First, the suggested changes are merely stylistic and not legally founded or required. Even though the term “comprises” has been repeatedly interpreted in case law to have a particular meaning in the context of patent claims, there is no legal basis for prohibiting applicants from also using the term in other sections of an application, for its plain meaning and/or for its court-interpreted meaning.

Furthermore, in light of the recent reversal in policy, which no longer prohibits the use of the Abstract to interpret the scope of claims (see Federal Register, Vol. 68, No. 125, Section 1.72; and Hill-Rom Co. v. Kinetic Concepts, Inc., 209 F.3d 1337, 1341 n.1, 54 USPQ2d 1437, 1440 n.1 (Fed. Cir. 2000)), Applicant prefers to use consistent terminology throughout the application so that inference or implication of different meanings from use of different terms is avoided for terms that are intended to have the same meaning. Based on the foregoing, withdrawal of the objection to the specification is kindly requested.

## REJECTIONS BASED ON PRIOR ART

### Rejection under 35 U.S.C. §102(e)

Claims 1, 8 and 10 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Alfero-Kuronya (“*Alfero-Kuronya*”; U.S. Pat. No. 6,505,967). This rejection is traversed.

#### Claim 1

The Office Action contends that opening 30 of *Alfero-Kuronya* is support structure that teaches something similar to the outer sheath recited in Claim 1 of the application. Because an opening in a structure does not meet the definition of “sheath” proposed in the Action (i.e., “any of various covering or support structures that are applied like or resemble in appearance or function the sheath of a blade”), it is assumed that the Action intended to rely on the attachment 28, with bottom member 16, of *Alfero-Kuronya* for an alleged teaching of the outer sheath. The remarks presented herein are based on that assumption.

First, the Action appears to rely on magnets 18 of *Alfero-Kuronya* for the one or more first magnets and one or more second magnets of Claim 1. Claim 1 recites the following feature:

one or more second magnets, positioned between the distal end of the outer sheath and a distal end of a removable inner bag, to attract metallic debris that enters the removable inner bag (underline added).

*Alfero-Kuronya* does not teach or suggest use of magnets (a) positioned between the distal end of the outer sheath and a distal end of a removable inner bag (described in paragraphs 0040 and 0042 and, in exploded form, in FIG. 1), (b) to attract metallic debris that enters the removable inner bag. The magnets 18 of *Alfero-Kuronya* are not used to attract metallic debris entering the inner bag, rather *Alfero-Kuronya* teaches the use of magnets 18 to affix attachment 18 to external structure (col. 5, lines 25-55). Furthermore, the magnets 18 of

*Alfero-Kuronya* are not positioned between a distal end of a removable inner bag and the distal end of the outer sheath, as clearly and unambiguously shown in Figs. 4, 6 and 8.

In response to prior remarks, the Action states that “recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.” A structural difference between the embodiment recited in Claim 1 and the *Alfero-Kuronya* reference, which results from use of the second magnet to attract metallic debris entering the inner bag, is the position of the second magnet between the “bottom” (i.e., distal end) of removable inner bag and the “bottom” (i.e., distal end) of the outer sheath. Therefore, the embodiment recited in Claim 1 is patentably distinguished from the *Alfero-Kuronya* reference and is patentable thereover.

Next, Claim 1 recites “the inner bag is disposed within the outer sheath” (underline added). *Alfero-Kuronya* does not teach or suggest an inner bag (according to the Action, bag 22) disposed within an outer sheath (according to the Action, attachment 28 or opening 30). Hence, for this additional reason, Claim 1 is not anticipated by *Alfero-Kuronya* and is patentable thereover. For the foregoing reasons, withdrawal of the rejection of Claim 1 under 35 U.S.C. §102(e) is respectfully requested.

#### Claim 8

Claim 8 depends directly from Claim 1. Hence, for a valid anticipation rejection of Claim 8, a prior art reference must disclose and teach each and every element of Claim 8 and Claim 1. The Action alleges that element 16 of *Alfero-Kuronya* anticipates the magnet housing that is recited in Claim 8. *Alfero-Kuronya* does not disclose and does not anticipate an apparatus that includes all of the features of Claim 8, including the features of Claim 1, in a single apparatus. In the configuration illustrated in Figs. 1 and 2 of *Alfero-Kuronya*, there is no

structure 28 on which the Action relies for an outer sheath. In the configuration illustrated in Figs. 3 and 4 of *Alfero-Kuronya*, planar member 16 does not function as a magnet housing. Rather, planar support member 16 is used to “securely retain collection bag 22” and for “creating a square or rectangular opening 32 for the particles to fall through” (col. 5, lines 13-17). For the foregoing additional reasons, Claim 8 is patentable over *Alfero-Kuronya*. Withdrawal of the rejection of Claim 8 under 35 U.S.C. §102 is requested.

#### Claim 10

Claim 10 depends from Claim 1 and, therefore, is patentable over *Alfero-Kuronya* for the same reasons as Claim 1. Withdrawal of the rejection of Claim 10 under 35 U.S.C. §102 is requested.

#### Rejections under 35 U.S.C. §103(a)

(I) Claims 1 and 8-12 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yoshikawa (“*Yoshikawa*”; U.S. Patent No. 5,367,278) in view of Anderson et al. (“*Anderson*”; U.S. Patent No. 5,871,114). This rejection is traversed.

#### Claim 1

As with *Alfero-Kuronya*, *Yoshikawa* does not teach or suggest use of magnets (a) positioned between a distal end of a removable inner bag and the distal end of the outer sheath, (b) to attract metallic debris that enters the removable inner bag. The magnets 4 of *Yoshikawa* are not used to attract metallic debris entering the inner bag, rather *Yoshikawa* teaches the use of magnets to attach a plastic container to a steel structure (e.g., col. 2, lines 40-44). Furthermore, the magnets of *Yoshikawa* could not be positioned between a distal end of a removable inner bag, which is encompassed by the outer sheath, and the distal end of the outer sheath (according to the Action, container 1), as clearly and unambiguously shown in Fig. 1.

The magnets of *Yoshikawa* are positioned externally, not internally, to the alleged sheath, and are not physically able to be positioned between the sheath and a bag that is encompassed by the sheath.

As with *Alfero-Kuronya*, a structural difference between the embodiment recited in Claim 1 and the *Yoshikawa* reference, which results from use of the second magnet to attract metallic debris entering the inner bag, is the position of the second magnet between the bottom of the removable inner bag and the bottom of the outer sheath. Therefore, the embodiment recited in Claim 1 is patentably distinguished from the *Yoshikawa* and *Anderson* references and is patentable thereover.

For the foregoing reasons, a combination of *Yoshikawa* and *Anderson* does not make obvious Claim 1 because such a combination would not include each and every feature recited in Claim 1. Therefore, Claim 1 is patentable over these cited references. Withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Yoshikawa* and *Anderson*, is kindly requested.

#### Claims 8-12

The remaining claims under this rejection, Claims 8-12, depend directly or indirectly from Claim 1. Therefore, Claims 8-12 are patentable over *Yoshikawa* and *Anderson* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claims 8-12 under 35 U.S.C. §103, based on *Yoshikawa* and *Anderson*, is requested.

(II) Claims 1, 12 and 13 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Sutton (“*Sutton*”; U.S. Patent No. 6,179,025). This rejection is traversed.

The Office Action did not address previously-presented remarks with respect to this previously-presented rejection. The Examiner is reminded that Patent Office procedure (stated

in MPEP 707.07(f) is “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”

#### Claim 1

*Sutton* does not disclose or suggest use of one or more magnets (a) positioned between a distal end of a removable inner bag and the distal end of the outer sheath, (b) to attract metallic debris that enters the removable inner bag. By contrast, *Sutton* discloses a carry bag with a pouch insert, particularly handbags, diaper bags, briefcases, knapsacks, and tote bags (col. 1, lines 19-22), which can be used to store personal items (col. 2, line 67). The magnetic snap fastener portion 13 functions to couple inner pouch 11 to exterior cover 12. *Sutton* does not disclose, suggest or motivate an apparatus for containing debris, which uses a magnet positioned as recited in Claim 1, to help contain and secure within an inner bag any magnetic debris that may enter the inner bag, such as when being used to contain metal filings generated by drilling into a switchgear enclosure.

Similarly to above, a structural difference between the embodiment recited in Claim 1 and the *Sutton* reference, which results from use of the second magnet to attract metallic debris entering the inner bag, is the position of the second magnet between the bottom of the removable inner bag and the bottom of the outer sheath. Therefore, the embodiment recited in Claim 1 is patentably distinguished from the *Sutton* reference and is patentable thereover.

In addition, it is improbable and unreasonable that one skilled in the art of electrical/electronic safety tools would look to the art of carrying bags for a suggestion or motivation with respect to developing a safety tool for containing debris from electrical work. In a case in which a combination of two references (the first relating to a metal hose clamp without a hook, and the second relating to a plastic hook and eye fastener used in garments)

were used in support of an obviousness rejection of a claim that involved an improvement in a metal hose clamp having a preassembly hook, the Federal Circuit stated that “[t]he combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination” (underline added). *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

Therefore, *In re Oetiker* stands for the proposition that it is not proper to combine non-analogous prior art. One skilled in the art of electrical safety tools would not find a motivation or suggestion to turn to the *Sutton* reference to develop that which is recited in Claim 1 because the *Sutton* reference is non-analogous art. Consequently, one skilled in the art of electrical safety tools would not find obvious the invention recited in Claim 1 based on the *Sutton* reference.

For all the foregoing reasons, a prima facie case of obviousness is not established for Claim 1 based on *Sutton*. Therefore, Claim 1 is patentable over *Sutton* and withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Sutton*, is requested.

#### Claims 12 and 13

The remaining claims under this rejection, Claims 12 and 13, depend directly or indirectly from Claim 1. Therefore, Claims 12 and 13 are patentable over *Sutton* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claims 12 and 13 under 35 U.S.C. §103, based on *Sutton*, is requested.

(III) Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Sutton* in view of Koret (“*Koret*”; U.S. Patent No. 2,875,802). This rejection is traversed.

The Office Action did not address previously-presented remarks with respect to this previously-presented rejection. The Examiner is again reminded of the Patent Office procedure stated in MPEP 707.07(f).

Claims 2 and 3

As Claim 2 depends from Claim 1, the foregoing remarks presented in reference to Claim 1 and the *Sutton* reference are equally applicable to Claim 2. That is, *Sutton* (1) does not disclose or suggest an apparatus for containing debris, in which one or more second magnets are positioned between the bottom of the inner bag and the bottom of the outer sheath to attract metallic debris that enters a removable inner bag; and (2) one skilled in the art of electrical/electronic safety tools would not look to the art of carrying bags for a suggestion or motivation with respect to developing a safety tool for containing debris from electrical work. The same rationale applies to *Koret*, which also discloses a handbag, purse, or the like, but makes no mention of an apparatus for containing magnetic debris. Hence, one skilled in the art of electrical safety tools would not be motivated to look to the *Sutton* and *Koret* references for teachings about electrical safety tools and, therefore, would not find obvious the invention recited in Claim 2 based on these references.

Withdrawal of the rejection of Claim 2 under 35 U.S.C. §103, based on *Sutton* and *Koret*, is requested. Because Claim 3 depends from Claim 2, Claim 3 is patentable over *Sutton* and *Koret* for at least the foregoing reasons discussed in reference to Claim 2.

(IV) Claims 1-4, 6-8 and 12 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Lee (“*Lee*”; U.S. Patent No. 4,872,401) in view of Crawley (“*Crawley*”; U.S. Patent Application Publication No. 2002/0025086). This rejection is traversed.



### Claim 1

*Lee* does not disclose or suggest use of one or more magnets (a) positioned between a distal end of a removable inner bag and the distal end of the outer sheath, (b) to attract metallic debris that enters the removable inner bag. By contrast, *Lee* discloses a device for improving the flavor of products (e.g., col. 1, lines 34-37). The magnetic pieces 20 functions are clearly annular (col. 2, lines 4-26; Fig. 1) and used to produce a magnetic field to affect the properties of a substance held therein (e.g., col. 1, lines 14-31). *Lee* does not disclose, suggest or motivate an apparatus for containing debris, which uses a magnet positioned as recited in Claim 1, to help contain and secure within an inner bag any magnetic debris that may enter the inner bag. The same rationale applies to *Crawley*, which discloses a substantially rigid open mouth to a bag, but makes no mention of an apparatus for containing magnetic debris.

Similarly to above, a structural difference between the embodiment recited in Claim 1 and the *Lee* and *Crawley* references, which results from use of the second magnet to attract metallic debris entering the inner bag, is the position of the second magnet between the bottom of the removable inner bag and the bottom of the outer sheath. Therefore, the embodiment recited in Claim 1 is patentably distinguished from the *Lee* and *Crawley* references and is patentable thereover.

In addition, it is improbable and unreasonable that one skilled in the art of electrical/electronic safety tools would look to the art of food, liquid, tobacco products for a suggestion or motivation with respect to developing a safety tool for containing debris from electrical work. Therefore, one skilled in the art of electrical safety tools would not find a motivation or suggestion to turn to the *Lee* and *Crawley* references to develop that which is recited in Claim 1 because the *Lee* and *Crawley* references are non-analogous art.

Consequently, one skilled in the art of electrical safety tools would not find obvious the invention recited in Claim 1 based on the *Lee* and *Crawley* references.

For all the foregoing reasons, a prima facie case of obviousness is not established for Claim 1 based on *Lee* and *Crawley*. Therefore, Claim 1 is patentable over *Lee* and *Crawley* and withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Lee* and *Crawley*, is requested.

Claims 2-4, 6-8 and 12

The remaining claims under this rejection, Claims 2-4, 6-8 and 12, depend directly or indirectly from Claim 1. Therefore, Claims 2-4, 6-8 and 12 are patentable over *Sutton* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claims 2-4, 6-8 and 12 under 35 U.S.C. §103, based on based on *Lee* and *Crawley*, is requested.

(V) Claims 1-3, 6-8 and 10-13 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Lee*. This rejection is traversed.

Claim 1

As discussed in reference to the *Lee/Crawley* rejection, *Lee* does not disclose, suggest or motivate an apparatus for containing debris, which uses a magnet positioned as recited in Claim 1, to help contain and secure within an inner bag any magnetic debris that may enter the inner bag. Therefore, the embodiment recited in Claim 1 is patentably distinguished from the *Lee* reference and is patentable thereover. Withdrawal of the rejection of Claim 1 under 35 U.S.C. §103, based on *Lee* and *Crawley*, is requested.

Claims 2, 3, 6-8 and 10-13

The remaining claims under this rejection, Claims 2, 3, 6-8 and 10-13, depend directly or indirectly from Claim 1. Therefore, Claims 2, 3, 6-8 and 10-13 are patentable over *Lee* for at least the foregoing reasons discussed in reference to Claim 1. Withdrawal of the rejection of Claims 2, 3, 6-8 and 10-13 under 35 U.S.C. §103, based on *Lee*, is requested.

CONCLUSION

For at least the reasons indicated above, Applicants submit that all of the pending claims currently under consideration (1-13) present patentable subject matter over the references of record, and are in condition for allowance. Therefore, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner has questions regarding this case, the Examiner is invited to contact Applicant's undersigned representative.

Please charge any shortages in fees due in connection with the filing of this paper, including extension of time fees, or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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